

REMARKS

The Office action dated November 5, 2008, and the references cited have been fully considered. In response, please enter the amendments and consider the remarks presented herein. Reconsideration and/or further prosecution of the application is respectfully requested.

Applicants appreciate the thoughtful examination of the application. Applicants also appreciate the Office returning the initialed, signed and dated 1449's indicating the full consideration of the listed references.

In regards to the objections to the specification, the following remarks reference the same lettered paragraphs of the Office action to which they are directed.

(a) Applicants appreciate the Office pointing out the sentence. Although Applicants believe it is correct, Applicants have amended herein to replace "that" with "by which" as it makes the sentence easier to read.

(b) Applicants respectfully traverse this objection, and there is no requirement for a formal definition of the term "accounting data" as the specification is clear to one skilled in the art and there is no limitation of "accounting data" used in a claim. Applicants refer the Office to page 4, last paragraph of the original disclosure which discusses need for collection of statistics and other information, which can, for example, can provide the metering base for real time and post processing applications including network traffic accounting, usage based network billing, network planning, network monitoring, outbound marketing, and data mining capabilities for both service provider and enterprise customers. The paragraph continues pointing out the desirability of a scalable system for the collection of data and information, then expressly states that "[d]esired is a new mechanism for collecting accounting and other data." One skilled in the art would understand what is meant from at least this paragraph. Moreover, Applicants believe this objection is being caused by the use of the phrase "accounting data" in the preamble of certain claims. Applicants remind the Office that a preamble often is used to merely state a

possible purpose or possible intended use of a claim. In which case, the preamble is not considered a limitation and is of no significance to claim construction. MPEP § 2111.02 (citations omitted). No claim limitation within the body of a claim refers to "accounting data." For at least these reasons, the specification is complete and accurate, and Applicants respectfully request the objection specification to be withdrawn.

(c) Applicants respectfully traverse this rejection, as this application does not claim priority to the other applications filed on the same day and referenced in the Office action. The application claims CIP priority status to a single application, which is stated in the first sentence of the originally filed application. The Office action cites MPEP § 606.01 and § 608.01(a) for the basis of its objection. However, MPEP § 608.01(a) references 37 CFR § 1.78 and MPEP § 201.11, which explain that this requirement of listing applications is for applications to which priority is claimed (e.g., under 35 USC § 120). A related case, as defined in 37 CFR § 1.78 is one to which an application claims the benefit of priority to another application. Applicants do not claim priority to the applications filed on the same day. There is no Rule or Law requiring Applicants to cite in this Cross-Reference to Related Applications section applications that are not related. In fact, it would be contrary to the purpose of the Rule to have a listing of non-related cases in the section entitled "Cross-Reference to Related Applications." Applicants have expressly made the Office aware of these other application via the appropriate means provided for by the Rules and MPEP – that being an Information Disclosure Statement. Applicants respectfully request this objection be withdrawn as the specification complies with the Law, Rules and MPEP.

For at least these reasons, Applicants respectfully request all objections to the specification be withdrawn.

Next, in regards to the claim objections, Applicants appreciate the Office notifying Applicants of the typographical errors, which have been corrected herein. For at least these reasons, Applicants request all claim objections be withdrawn.

Next, Applicants respectfully traverse the § 101 rejections. First, the Office action has failed to present a *prima facie* case of an obviousness-type double patenting rejection as it fails to comply with the MPEP § 804 and provide an analysis of why each of the claims would be obvious over another claim. This is an analysis that parallels a § 103 obviousness analysis and subsequent proper statement of the rejection. The burden is on the Office to initially present a rejection for each and every claim. Moreover, the Office's presentation of the rejection is perplexing, as it seems to compare the specifications, rather than the limitations of claims. Applicants have compared the claims, and do not see a basis for the claims presented herein being unpatentable as being obvious in light of the claims of US Patent 7,177,978.

Moreover, the Office relies on *In re Schneller* as authority for making the § 101 rejection. **MPEP § 804¹ requires the approval of the TC director before a nonstatutory double patenting rejection can be made based on *In re Schneller*.** Applicants respectfully request an Interview with the TC Director to discuss the appropriateness of this rejection, and so that the TC Director's approval, if the rejection is maintained, will be made of public record in this application's image file wrapper.

¹ "The decision in *In re Schneller* did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. The court in *Schneller* cautioned 'against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations.' *Schneller*, 397 F.2d at 355, 158 USPQ at 215. Nonstatutory double patenting rejections based on *Schneller* **will be rare**. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made." (**Emphasis is original.**)

Applicants respectfully submit that the claims are patentably distinct over claims the issued claims in US Patent 7,177,978. Moreover, and stepping back and looking at the bigger picture, Applicants believe that if they had included all claims in a single application, the application would have been subject to a restriction requirement, wasting both Applicant's as well as the Office's time, and resulting in extra claim fees paid by Applicants. For at least these reasons, Applicants respectfully request all § 101 rejections be withdrawn.

Next, Applicants respectfully traverse the § 112 rejections of the claims. The term "accounting data" is only used in the preamble of the claims and as part of the phrase "for generating accounting data." This is merely a statement of a possible purpose or possible intended use of a claim, and no claim limitation within the body of a claim recites "accounting data.". Therefore, the preamble of each pending claim is not considered a limitation and is of no significance to claim construction. *See*, MPEP § 2111.02 (citations omitted). It has been a long-time practice to include an example use of a claim in the preamble of a claim to give it some context, while not imposing a limitation on the application of the claim to other contexts. There is a whole series of cases on this subject in which an exemplary use is not a limitation on a claim. For at least these reasons, Applicants respectfully traverse the conclusions stated in the Office action that "the phrase 'accounting data' is critical or essential to the practice of the invention as it is currently recited in the preamble of all the seven independent claims," or a claim is rendered indefinite for the statement of a possible use in the preamble of the claim.

Moreover, Applicants refer the Office to page 4, last paragraph which discusses need for collection of statistics and other information, which can, for example, can provide the metering base for real time and post processing applications including network traffic accounting, usage based network billing, network planning, network monitoring, outbound marketing, and data mining capabilities for both service provider and enterprise customers. Many, if not all, of the claims include determining which accounting mechanism or counter and updating it accordingly. Packet counts or other usage data are examples of accounting data, which can be used to

generate usage-based bills. It is such a basic concept that for packet-implemented services that are billed based on usage, that there must be some data collected based on the usages (e.g., statistics, counters, etc.). One skilled in the art would understand such a fundamental concept, even before reading the specification, but especially after reading the specification as discussed *supra*.

For at least the reason that the preambles of the claims merely state exemplary usage for an embodiment of the respective claim as discussed *supra*, Applicants respectfully request the § 112 rejections of the claims be withdrawn.

In regards to the amendments to the claims, Applicants again appreciate the Office detecting the typographical errors, which have been corrected herein. Applicants respectfully traverse all claim objections and rejections as discussed herein, including all rejections based on prior art. However, Applicants have elected to amend some claims and add some claims based on Applicants' current desired claim wording and formats.

First, Applicants did not like the wording of original claim 1, and therefore, have amended it in accordance with current drafting preferences, which may make more reader-friendly. Claim 1 is amended to recite configuring a mechanism for accumulating information, with support provided at least by FIG. 8B and its discussion on page 32 of the original application ("FIG. 8B illustrates a process used in one embodiment to configure a mechanism for accumulating information based on access control entries"). An access control list entry / access control list (ACL) is well-known in packet switching, with an example of which illustrated in FIG. 8A, and discussed at least on pages 31-32 of the original disclosure (which illustrates an ACL having entries with permit and deny conditions.) However, rather than relying simply the term "accesses control list entry", claim 1 is amended to recite that at least one of the access control list entries includes a permit condition and one includes a deny condition, in order to give it limitations consistent with the definition of an access control list entry. Additionally, while amending the claim, the preamble of a possible use of claim 1 has been

removed. Additionally, the claim limitations were better tied together such that the identification of the particular accounting mechanism was identified based on matching the particular item against the access control list entries (at least the ones with accounting requests), with support at least by FIG. 8C and its discussion at least on pages 32-33. Finally, some wording was adjusted commensurate with the original claim language, and to make it easier to read. Also, each of claim 1's dependent claim 2-4 is amended to correct typographical error(s) and/or to adjust its language to be consistent with amended claim 1.

Additionally, new claims 21-24 are added directly based on claims 1-4, respectively, and on original claims 13-15 (computer-readable medium claims) and on FIG. 1E (illustrating memory and processing element) and its discussion in the original disclosure. New independent claim 21 is added directly based on independent claim 1.

Applicants have canceled claims 13-15 and 19-20 to free up previously paid claim fees for these new claims.

Turning to the claim rejections based on prior art, all claims stand rejected under 35 USC § 103(a) as being unpatentable over Lakshman et al., US Patent 5,951,651 in view of Ben Nun et al., US Patent 6,831,893. Applicants respectfully traverse all claim rejections for at least the reasons discussed herein, including that the Office action fails to present a *prima facie* rejection of any claim, and that the prior art of record, alone or in combination, neither teaches nor suggests all of the claim limitations of any pending claim.

The burden is on the Office Action to establish a *prima facie* case of obviousness, and obviousness under 35 USC § 103(a) requires the prior art reference (or references when combined) must teach or suggest all the claim limitations; and requires the Office action to address each and every claim limitation of each and every claim.

Turning to independent claim 1, claim 1 recites that the mechanism is configured based on information contained in an access control list (e.g., 800 of FIG. 8A), with some of the entries including accounting requests (e.g., 801, 802 of FIG. 8A). Additionally, Applicants have

amended claim 1 to include limitations that access control entries contain at least one permit condition and at least one deny condition (e.g., 803, 804 of FIG. 8A). The Office action fails to address the limitation of access control entries, and Applicants cannot locate in Lakshman et al. nor Ben Nun et al. any mention of an "access control list." For at least these reasons, the Office action fails to present a *prima facie* rejection of independent claim 1, and its dependent claims 2-4. Additionally, Applicants respectfully submit that the recited combination of linking access control entries with accounting requests to update accounting mechanisms as recited in claims 1 -4 and 21-25 is neither taught nor suggested by the prior art of record. For at least these reasons, claims 1-4 and 21-25 are believed to be allowable.

Applicants further traverse the rejections of claims 5-12 and 16-18 as each claim recites a limitation of an associative memory and an adjunct memory, but the Office action fails to present where these are taught by Lakshman et al. or Ben Nun et al., and Applicants cannot locate in Lakshman et al. nor Ben Nun et al. any mention or use of an associative memory.

Finally, Applicants respectfully submit that the rejections presented in the Office action fail to comply with the MPEP § 706 and specifically 37 CFR 1.104(c)(2), which provides:

(2) ... When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Thus, the Office action must clearly articulate any rejection with the particular part relied upon designated as clearly as possible. The statement of the rejection of most claims is simply: (1) a copy of the claim; and (2) the statement "(See Lakshman Background and Summary, and FIGs. 3 to 8 and their text)." In other words, the Office is simply rejecting the claims based on its conclusion that it is taught by Lakshman et al, and leaving it up to Applicants to guess what the Office means, and to search through almost all of Lakshman et al. in such process. These rejections fail to comply with the MPEP.

Moreover, if the Office did the proper analysis, documenting the rejection is simple (and required by the MPEP). It is basically just communicating the analysis and informing Applicants

for each recited element/limitation the teaching in the reference that the Office is relying upon. Due Process as well as the MPEP requires the Office to give Applicants proper notice as to the complete grounds of a rejection. Applicants respectfully suggest after each element/limitation of the claim, the Office merely put in parenthesis the source of the rejection – e.g., recited widget (Lakshman et al., element 222, FIG. 0), wherein ... (Lakshman et al., col. 0, lines 13-19). Again, this request and requirement of the MPEP is simply to fully communicate a properly performed analysis of a claim.

For at least these reasons, the Office action (a) fails to present a *prima facie* rejection of any pending claim; and (b) the prior art of record neither teaches nor suggests all the recited claim limitations of any pending claim. It is well-established law that the burden is on the Office to initially present a *prima facie* unpatentability (e.g., anticipation, obvious) rejection, before Applicant has any burden of proof of disproving any application of a cited reference against a claim. *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (C.C.P.A. 1967); *Ex parte Skinner*, 2 USPQ2d 1788, 1788-89 (B.P.A.I. 1986). Therefore, for at least the reasons presented herein, the Office action fails to include a *prima facie* unpatentability rejection of any claim, and Applicants have no further duty to discuss any other issues or application of a cited reference against a claim.

Finally, assuming the Office action complies with MPEP § 706 and 37 CFR 1.104(c)(2), then the Office cited the best prior art references available. As the best prior art references available neither teaches nor suggests all the claim limitations of any pending claim, then all pending claims are believed to be allowable over the best prior art available, and Applicants request all rejections be withdrawn, all pending claims be allowed, and the application be passed to issuance.

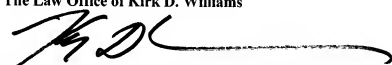
Final Remarks. In view of the above remarks and for at least the reasons presented herein, all pending claims are believed to be allowable over all prior art of record, the application is considered in good and proper form for allowance, and the Office is respectfully requested to issue a timely Notice of allowance in this case. Applicant requests any and all rejections and/or objections be withdrawn. If, in the opinion of the Office, a telephone conference would expedite the prosecution of the subject application, the Office is invited to call the undersigned attorney, as Applicants are open to discussing, considering, and resolving issues.

Applicants request a one-month extension of time is required. Should a different extension of time be deemed appropriate, Applicants hereby petition for such deemed extension of time. Applicants further authorize the charging of Deposit Account No. 501430 for any fees that may be due in connection with this paper (e.g., claim fees, extension of time fees) as required in addition to the payment made herewith using EFS-Web.

Respectfully submitted,
The Law Office of Kirk D. Williams

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By



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